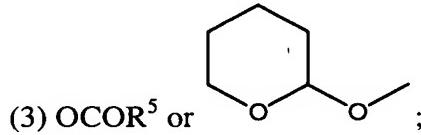


## **REMARKS**

The Examiner has required Applicant to elect a single group for each of the variables recited in claim 1.

In particular, the Examiner has required the election of one group from each of K<sup>1</sup>, R<sup>1</sup> and R<sup>2</sup> and W as follows:

From K<sup>1</sup>: (1) COOH, its ester and C(O)HCN;  
(2) CHO;



- (4) SO<sub>3</sub>H or SO<sub>2</sub>NH<sub>2</sub>;  
(5) a group bonded through OP containing groups;  
(6) an O (solely) containing hetero ring other than that of (3);  
and

- (7) an N containing hetero group.

From R<sup>1</sup> and R<sup>2</sup>: (1) at least one is phenyl or benzyl;  
(2) at least one is alkenyl or alkynyl;  
(3) both are alkyl; and  
(4) are taken together to form cycloalkyl.

From W: (1) H;  
(2) acyclic forming an ether;  
(3) aromatic forming an ether;  
(4) heterocyclic forming an ether;  
(5) attached through a Si atom; and  
(6) a group forming an ester.

For the reasons set forth below, Applicant respectfully traverses the restriction requirement.

It is improper for the United States Patent and Trademark Office (“USPTO”) to refuse to examine that which applicant regards as their invention, unless the subject matter lacks unity of invention. *In re Harnish*; 631 F.2d 716 (C.C.P.A. 1980). Unity of invention exists where compounds in a Markush group share a common utility and share a substantial structural feature disclosed as being essential to that utility. M.P.E.P. § 803.02. Applicant submits that the compounds of the Markush group set forth in claim 1 share the substantial core structural feature of an alkyl chain substituted at specific sites which is further

substituted with a terminal O-group. Furthermore, this structural feature is significant to the utility of the compounds as intermediates useful for the preparation of biologically active ether compounds. Accordingly, because unity of invention exists with respect to the compounds of claim 1, Applicant respectfully submits that it is improper for the USPTO to refuse to examine claim 1 in its entirety.

Alternatively, even if it is determined that a Markush group is directed to independent and distinct inventions, an Examiner must examine all the members of the Markush group on the merits if the examination can be made without serious burden. M.P.E.P. § 803.02. Applicant respectfully submits that the examination of the Markush group set forth in claim 1 would not pose a serious burden on the Examiner in view of the specific sites of substitution on the alkyl chain, the limited number of groups recited for each variable and the requirement of a terminal O-group.<sup>1</sup>

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the present restriction requirement and examine claim 1 on the merits in its entirety.

In order to be fully responsive to the restriction requirement, however, Applicant provisionally elects with traverse the following groups from the variables recited in claim 1:

- From K<sup>1</sup>: (1) COOH, its ester and C(O)NHCN;  
From R<sup>1</sup> and R<sup>2</sup>: (4) are taken together to form cycloalkyl; and  
From W: (2) acyclic forming an ether.

Applicant respectfully requests that the above remarks be entered in the present application file. No fee is believed to be due in connection with this Response other than that in connection with the Petition for Extension of Time Under C.F.R. §1.136(a); however, in the event that any other fee is due, please charge the required fee to Jones Day Deposit Account No. 50-3013.

Date: November 17, 2004

Respectfully submitted,  
*Anthony M. Insogna*, Reg. No. 35,203  
By: *Mil J. Brunner*, Reg. No. 47,458 35,203

Anthony M. Insogna (Reg. No.)

**JONES DAY**  
222 East 41st Street  
New York, New York 10017  
(858) 314-1130

Enclosures

<sup>1</sup> In addition, Applicant notes the considerable expense that would result if it must pursue each of the 168 groups that have been found for claim 1 in a separate application.